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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/609,073	06/30/2000	CONNIE T MARSHALL	ODS-9	2964
1473	7590	02/11/2004	EXAMINER	
FISH & NEAVE 1251 AVENUE OF THE AMERICAS 50TH FLOOR NEW YORK, NY 10020-1105			ASHBURN, STEVEN L	
			ART UNIT	PAPER NUMBER
			3714	22
DATE MAILED: 02/11/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/609,073	MARSHALL ET AL.	
	Examiner	Art Unit	
	Steven Ashburn	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 20 November 2003.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-19 and 37-48 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-19 and 37-48 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

Double Patenting

Claims 1-19 and 37-48 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over either claims 1-59 of Brenner et al., U.S. Patent 6,004,211 (Dec. 21, 1999) (hereinafter “*Brenner ‘211*”).

This holding, incorporated herein, is maintained from the prior action for the cited claims. Response to the applicant’s remarks are provided below and incorporated herein.

Claim Rejections - 35 USC § 103

Claims 1-19 and 37-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brenner, U.S. 5,830,068 (Nov. 3, 1998) in view of Dan Wagner et al., ‘The Human Factors Design Guide’, DOT/FAA/CT-96/1 (Jan. 15, 1996) (hereinafter “*HFDG*”) and Lawler et al., U.S. 5,805,763 (Sep. 8, 1998).

This holding, incorporated herein, is maintained from the prior action for the cited claims. Response to the applicant’s remarks are provided below and incorporated herein.

Response to Arguments

Applicant’s arguments filed Nov. 20, 2003 with respect to the obviousness-type double patenting rejection of claims 1-19 and 37-48 in view of *Brenner ‘068* are persuasive. See pp. 14-15. Therefore, the rejection has been withdrawn.

Applicant’s arguments filed Nov. 20, 2003 with respect to the obviousness-type double patenting rejection of claims 1-19 and 37-48 in view of *Brenner ‘211* are not persuasive. The applicant asserts that

the rejection is improper because the features claimed in *Brenner '211* are fully supported by the disclosure of *Brenner '068* patent. The examiner respectfully disagrees.

A rejection based on nonstatutory double patenting is based on a judicially created doctrine grounded in public policy so as to prevent the unjustified or improper timewise extension of the right to exclude granted by a patent. *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re White*, 405 F.2d 904, 160 USPQ 417 (CCPA 1969); *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968); *In re Sarett*, 327 F.2d 1005, 140 USPQ 474 (CCPA 1964). The A double patenting rejection of the obviousness-type is “analogous to [a failure to meet] the nonobviousness requirement of 35 U.S.C. 103” except that the patent principally underlying the double patenting rejection is not considered prior art. *In re Braithwaite*, 379 F.2d 594, 154 USPQ 29 (CCPA 1967). Therefore, any analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. 103 obviousness determination. *In re Braat*, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985).

MPEP 804-II-B-1 states the proper method analysis for non-statutory, obviousness-type double patenting:

... the analysis employed in an obviousness-type double patenting determination parallels the guidelines for a 35 U.S.C. 103(a) rejection, the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103 are employed when making an obvious-type double patenting analysis. These factual inquiries are summarized as follows:

- (A) Determine the scope and content of a patent claim and the prior art relative to a claim in the application at issue;
- (B) Determine the differences between the scope and content of the patent claim and the prior art as determined in (A) and the claim in the application at issue;
- (C) Determine the level of ordinary skill in the pertinent art; and
- (D) Evaluate any objective indicia of nonobviousness.

The conclusion of obviousness-type double patenting is made in light of these factual determinations (emphasis added).

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As described in the MPEP, obviousness-type double patenting is determined based on a comparison of claims, not disclosures. A single disclosure may support several independent inventions. Hence, the fact that two inventions share a common disclosure is of no matter in determining obvious-type double patenting.

In this case, the applicant did not file a terminal disclaimer limiting the term *Brenner '211* to the duration of *Brenner '068*. Hence, despite their common disclosures, the inventions claimed in *Brenner '211* and *Brenner '068* are independent. Consequently, a nonstatutory double patenting rejection in view of *Brenner '211* is proper is to prevent the unjustified or improper timewise extension of the right to exclude granted by the patent.

Applicant's arguments filed Nov. 20, 2003 with respect to the rejection under 35 USC § 103 have been fully considered but they are not persuasive. The examiner's response is provide below.

First, the applicant's note that the feature "automatically prompting the user to decide whether to record the race while interacting with the plurality of wager creation options", as stated in the examiner's rejection, is not present in pending claims. Instead, the applicants submit that claims 1 and 37 include the feature of automatically providing the user with an option to record a given race while the user is interacting with a plurality of wager creation options. Furthermore, the applicants submit that claim 19 and 48 include the feature of automatically providing the user with an opportunity to record a given race in response to the user placing a wager for the given race. The examiner concurs. Regardless of the differences in language, the rejection is maintained from the prior action for the reasons discussed below

Second, the applicant argues that the pending claims distinguish over the prior art because the gaming device described by the combination of *Brenner '068* with *HFDG* and *Lawler* does not suggest the features of automatically providing the user with an opportunity to record a given race (i) while the

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user in interacting with a plurality of wager creation options or (ii) in response to the user placing a wager for the given race. The examiner respectfully disagrees. The standard of patentability is what the prior art, taken as a whole, suggests to an artisan at the time of the invention. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). The question is not only what the references expressly teach, but what they would collectively suggest to one of ordinary skill in the art. *In re Simon*, 461 F.2d 1387, 1390, 174 USPQ 114, 116 (CCPA 1972).

In this case, *Brenner '068* discloses an “off-track” wagering system that allows users to create and place wagers by interacting with an interactive wager-creation interface and provides users with an option to record a race while the user is interacting with a plurality of wager-creation options. *See fig. 31-36*. The option to record a race is be selected from the sub-menu shown in fig. 34(596) rather than being displayed automatically as part of the wager-creation menu shown in fig. 31(448).

Lawler discloses a system that is analogous to *Brenner '068* in many ways. Similar to *Brenner '068*, wherein users browse race information and place orders to record racing videos, *Lawler* allows users to browse entertainment program information and place orders to record event videos. *See fig. 3; col. 1:45-2:40*. Furthermore, both systems are embodied on “set-top” boxes used to control television programming transmitted across broadcast networks. *See Lawler, fig. 1(18); col. 3:45-67*. *See Brenner '068, fig. 1, 2; col. 3:48-4:9*. Finally, both systems allow users the opportunity to record an event or set a reminder. *See Lawler, fig. 8, 9. See Brenner '068, col. 4:57-67*.

In regard to the claimed features, *Lawler* automatically provides users with an opportunity to record a given event (i) while the user in interacting with a plurality of menu options or (ii) in response to the user placing an order for a given item. *See fig. 4(a)(b), 6-10*. More specifically, it illustrates that a user is automatically given the option to record a program in response to an order while the user is interacting with the menu options. *See fig. 4A(222, 226, 224, 236, 238), 6(102, 136)*. As a result, users

are able to quickly and easily identify and select events using an interactive user-interface and to designate the selected event for recording. *See col. 1:45-50; col. 13:38-41.*

The *HFDG* provides guidance in the design of human-computer interfaces. It defines knowledge that is within the ordinary skill of artisans who work in the field of human-computer interfaces. Gaming artisan fall within this class because a primary element of wagering devices is the interface between a device and the player. Hence, the methods described in the *HFDG* would be within the ordinary knowledge of a gaming artisan.

As listed in the previous action, the *HFDG* suggests many features relevant to the pending claims. In particular, the teachings include the following:

- a. Prompting control entries: a system or application shall provide the user whatever information is required to guide control entries. *See 8.1.6.3.* For example, prompts may be incorporated into a display at any point in a transaction sequence that will be helpful, or prompts may appear in response to a request for help. *See id.* Notably, this suggests automatically prompting users with control entries. In addition, it suggests that is it a matter of design choice when to have the prompts occur.
- b. Display of all options: a menu shall display explicitly and completely all options available to a user at the current step in a transaction sequence. *See 8.1.11.1.7.*
- c. Easy selection of important options: hierarchical menus should permit immediate user access to critical or frequently selected options. *See 8.1.11.3.5.*

The methods listed above suggest to an artisan to modify the user interface disclosed in *Brenner '068* to provide a more effective user-interface. For example, in the system disclosed by *Brenner '068* wherein the wager-creation step is associated with additional options available in sub-menu, it suggest modifying the wager-creation menu to display all the available options. In addition, the *HFDG* suggests modifying the wager-creation interface to give immediate access frequently used functions.

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Thus, when the prior art is taken as a whole at a time prior to the invention it collectively suggest an “off-track” wagering system that automatically provides the user with an opportunity to record a given race while the user is interacting with a plurality of wager creation options or in response to the user placing a wager for the given race. As suggested by *Lawler*, the modification would enhance the user-interface disclosed by *Brenner* '068 by providing a reliable and easy method to record events for users who are otherwise unable to program the system. Furthermore, as suggested by the *HFDG*, automatically providing options in systems such as disclosed by *Brenner* '068 improves the user-interface by providing users whatever information is required to guide control entries by explicitly and completely displaying all options available to a user at the current step in a transaction sequence, permitting immediate user access to critical or frequently selected options, and eliminating the need for the user to remember the options.

Third, the applicant appears to assert that *Lawler* does not describe automatically providing the user with an option to record content. The examiner respectfully disagrees. The reference clearly illustrates that a user is automatically given the option to record a program in response to an order while the user is interacting with the menu options. *See fig. 4A(222, 226, 224, 236, 238), 6(102, 136)*. As discussed in the immediately above, the *HFDG* suggests automatically prompting users with options associated with a display.

Fourth, the applicant argues that *Lawler* and *HFDG* are not directed to interactive wagering devices or interacting with a wager-creation options. In response, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. *See In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

On its face, the argument that the prior art is non-analogous because it is not directed toward wagering devices or wagering transactions is wholly unpersuasive. An idea is not cordoned-off from the whole of human knowledge simply because it is directed toward wagering. Wagering devices are not an isolated art. Instead, they are complex systems comprised of many technologies from arts including, but not limited to, amusement devices, data processing, networking, computer graphics processing, electronic fund transfer, interactive video distribution, check-actuated control mechanisms, article dispensing, merchandising and cryptography. In this case, the claimed invention is a type of interactive video distribution system modified to offer wagering services. The wagering aspect does not delineate the system from interactive video distribution systems. Wagering services are merely a type of consumer business transaction. Whereas a typical transaction provides goods/services in exchange for consideration, a wagering transaction provides the service of a game of chance in exchange for consideration of a wager. Hence, the pending claims do not distinguish over the prior art of record because the service offered is a game of chance or because they involve a wagering transaction.

In regard to *Lawler*, the reference discloses system is that analogous to *Brenner '068* in many ways. In *Brenner '068* users collect race information and place orders to record racing videos. Similarly, *Lawler* allows users to collect entertainment program information and place orders to record event videos. See fig. 3; col. 1:45-2:40. Furthermore, both systems are embodied on "set-top" boxes used to control television programming transmitted across broadcast networks. See *Lawler*, fig. 1(18); col. 3:45-67. See *Brenner '068*, fig. 1, 2; col. 3:48-4:9. In addition, both systems allow users the opportunity to record an event or set a reminder. See *Lawler*, fig. 8, 9. See *Brenner '068*, col. 4:57-67. Hence, *Lawler* is analogous because the reference is in the field of the applicant's endeavor of providing an interactive user-interface. Also, *Lawler* is analogous because it is reasonably pertinent to the particular problem of simplifying the process of selecting a option to record an event though a interactive user-interface.

In regard to the *HFDG*, the reference teaches fundamental considerations for designing human-computer interfaces. Thus, its teachings are applicable to wagering devices because wagering devices require the similar considerations as human-computer interfaces found in other devices. Hence, the *HFDG* is reasonably pertinent to the particular problem of improving interactive user-interfaces.

Hence, for the reasons given above the examiner maintains that the prior art is analogous to the claimed invention.

Fifth, the applicant argues that there is no suggestion to combine the references. The examiner respectfully disagrees. "There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998).

In this case, *Lawler* discloses an analogous interactive user interface for an entertainment system allowing users to search and automatically record broadcast events. *See fig. 3; col. 1:45-2:40*. In particular, *Lawler* discloses a recording system allows users to quickly and easily select an event to record from an interactive menu and thereby solves the problem of users who remain unable to program their systems. *See col. 1:40-43, col. 13:38-42*. Hence, *Lawler* suggests the modification of *Brenner '068* because it is directed to the problem to be solved and explicitly suggests the modification.

Furthermore, the *HFDG* defines knowledge within the ordinary skill of an artisan who works in the field of human-computer interfaces. Moreover, it provides motivations for incorporating various design features into the interfaces. As discussed previously , the *HFDG* suggests improving user-interfaces by providing users whatever information is required to guide control entries, explicitly and completely displaying all options available to a user at the current step in a transaction sequence, permitting immediate user access frequently selected options, and eliminating the need for the user to remember the entries. *See supra*. Hence, the *HFDG* suggests the modification of *Brenner '068* based on

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the nature of the problems to be solved in interactive user-interfaces, the teachings of the *HFDG* with respect to providing improved interactive user-interfaces, and the knowledge of persons of ordinary skill in the art as defined by the *HFDG*.

Hence, when the disclosures of *Lawler* and the *HFDG* are taken as a whole by one of ordinary skill in the art of gaming devices, they collectively suggest modifying *Brenner '068* to add the feature of automatically provides the user with an opportunity to record a given race while the user is interacting with a plurality of wager creation options or in response to the user placing a wager for the given race. Moreover, this suggestion is found completely within the prior art and not based upon the applicant's disclosure.

Consequently, for all the reasons given above, the rejection of the pending claims is respectfully maintained.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Ashburn whose telephone number is 703 305 3543. The examiner can normally be

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reached on Monday thru Friday, 8:00 AM to 4:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

s.a.



MARK SAGER
PRIMARY EXAMINER